



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/728,793	11/30/2000	Thomas Lange	P-4581	2701
24209	7590	04/21/2004	EXAMINER	
GUNNISON MCKAY & HODGSON, LLP 1900 GARDEN ROAD SUITE 220 MONTEREY, CA 93940			HUTTON JR, WILLIAM D	
			ART UNIT	PAPER NUMBER
			2178	3
DATE MAILED: 04/21/2004				

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/728,793	LANGE, THOMAS	
	Examiner Doug Hutton	Art Unit 2178	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 07 May 2002.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-26 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 1-26 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 30 November 2000 is/are: a) accepted or b) objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)	4) <input type="checkbox"/> Interview Summary (PTO-413)
2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)	Paper No(s)/Mail Date. _____.
3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.	5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)
	6) <input type="checkbox"/> Other: _____.

DETAILED ACTION

Priority

Receipt of papers submitted under 35 U.S.C. 119(a)-(d) is acknowledged. The papers have been placed of record in the file.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-10 and 13-25 are rejected under 35 U.S.C. 102(b) as being anticipated by Martel, Jr. et al., U.S. Patent No. 5,251,292.

Claim 1:

Martel discloses a method of inserting a data object into a computer-generated document (see Column 1, Lines 7-10), comprising:

- converting a selected text portion of said computer-generated document containing at least one text instruction symbol into a data object (see Figures 1-2;

see Column 1, Line 1 through Column 26, Line 34 – the “selected text portion” of the document is that portion entered into the equation editor; the “selected text portion” includes a “text instruction symbol,” as described in the cited text; the “selected text portion” is converted into a “data object,” as described in the cited text) ; and

- returning said data object for insertion in said computer-generated document (the “data object” is returned for insertion into the document, as described in the cited text).

Claim 2:

Martel discloses the method of Claim 1, further comprising:

- inserting said at least one text instruction symbol in the form of text characters into the computer-generated document (see Figures 1-2; see Column 1, Line 1 through Column 26, Line 34 – the reference discloses this step in that specific set of text characters represent the “text instruction symbols”).

Claim 3:

Martel discloses the method of Claim 2, further comprising:

- selecting said text portion of said computer-generated document containing said at least one text instruction symbol (the reference discloses this step, as described in the above rejection for Claim 1).

Claim 4:

Martel discloses the method of Claim 1, wherein the data object comprises a mathematical formula (see Figures 1-2).

Claim 5:

Martel discloses the method of Claim 1, wherein the data object comprises at least one Greek character (see Figures 1-2).

Claim 6:

Martel discloses the method of Claim 1, wherein text characters in the selected text portion, which do not form a text instruction symbol, remain unchanged during the converting operation (see Figures 1-2; see Column 1, Line 1 through Column 26, Line 34 – the reference discloses this step, as described in the cited text).

Claim 7:

Martel discloses the method of Claim 1, further comprising:

- inserting the returned data object into the computer-generated document at a position of the selected text portion (see Column 1, Line 1 through Column 26, Line 34 – the reference discloses this step, as described in the cited text).

Claim 8:

Martel discloses the method of Claim 7, wherein content surrounding the data object has a format, and said method further comprises formatting the returned data object using said format (see Column 1, Line 1 through Column 26, Line 34 – the reference discloses this step in that the equations are automatically properly formatted).

Claim 9:

Martel discloses the method of Claim 1, further comprising:

- storing the data object with the computer-generated document (see Column 1, Line 1 through Column 26, Line 34 – the reference discloses this step, as described in the cited text).

Claim 10:

Martel discloses the method of Claim 1, wherein the data object is reconvertible into the text portion representing the data object (see Column 1, Line 1 through Column 26, Line 34 – the reference discloses this step, as described in the cited text).

Claims 13-22:

These claims are for computer software that performs the method of Claims 1-10. Thus, these claims are rejected using the same rationale.

Claims 23 and 24:

These claims are for a document created by the method of Claims 1, 4, 5 and 10.

Thus, these claims are rejected using the same rationale.

Claim 25:

This claim is for a computer network that performs the method of Claim 1. Thus, this claim is rejected using the same rationale.

Claims 1-26 are rejected under 35 U.S.C. 102(b) as being anticipated by Tittel, Ed et al., HTML 4 for Dummies, IDG Books Worldwide, Inc. (1998).

Claim 1:

Tittel discloses a method of inserting a data object into a computer-generated document (see Chapter 7 -- “Introducing the Unrepresentable: HTML Entities”), comprising:

- converting a selected text portion of said computer-generated document containing at least one text instruction symbol into a data object (the reference discloses HTML entities that are used to add special symbols into a web document; for example, if a web page designer wanted to put the mathematical equation “ $\int 2x=x^2$ ” onto a web document, then he would type in “∫2x=x²”; then, the invention would convert a “selected” portion of the document containing “text instruction symbols” into a “data object” in that the “∫” would be

converted into “ʃ” and the “²” would be converted into “²” and the entire equation would be displayed as “[$2x=x^2$]”; and

- returning said data object for insertion in said computer-generated document (the invention discloses this step in that the “data object” is returned for insertion into the web document).

Claim 2:

Tittel discloses the method of Claim 1, further comprising:

- inserting said at least one text instruction symbol in the form of text characters into the computer-generated document (in the above example, the “text instruction symbols” are “∫” and “²”).

Claim 3:

Tittel discloses the method of Claim 2, further comprising:

- selecting said text portion of said computer-generated document containing said at least one text instruction symbol (the reference discloses this step in that the text pattern is selected as the document is parsed by the browser).

Claim 4:

Tittel discloses the method of Claim 1, wherein the data object comprises a mathematical formula (the reference discloses this step, as specified in the above example).

Claim 5:

Tittel discloses the method of Claim 1, wherein the data object comprises at least one Greek character (the reference discloses this step in that the HTML entity “Σ” represents “ Σ ”).

Claim 6:

Tittel discloses the method of Claim 1, wherein text characters in the selected text portion, which do not form a text instruction symbol, remain unchanged during the converting operation (the reference discloses this step in that text characters “within the selected text portion” that do not form part of the text instruction symbol remain unchanged).

Claim 7:

Tittel discloses the method of Claim 1, further comprising:

- inserting the returned data object into the computer-generated document at a position of the selected text portion (the reference discloses this step in that the “data object” is entered into the web document “at the location of the selected text portion”).

Claim 8:

Tittel discloses the method of Claim 7, wherein content surrounding the data object has a format, and said method further comprises formatting the returned data

object using said format (the reference discloses this step in that the text “surrounding the data object” is formatted in a particular font and size and the “returned data object” is formatted using the same font and size).

Claim 9:

Tittel discloses the method of Claim 1, further comprising:

- storing the data object with the computer-generated document (the reference discloses this step in that the “data object” is stored with the web document).

Claim 10:

Tittel discloses the method of Claim 1, wherein the data object is reconvertible into the text portion representing the data object (the reference discloses this step in that the “data object” can be “undone” by revealing the source code for the web document).

Claim 11:

Tittel discloses the method of Claim 1, wherein said method is downloaded (the reference discloses this step in that the document is downloaded from a server).

Claim 12:

Tittel discloses the method of Claim 1, wherein said method is stored on a first computer system and said computer-generated document is stored on a second

computer system (the reference discloses this step in that the method is performed at the client computer and the document is stored on a server).

Claims 13-22:

These claims are for computer software that performs the method of Claims 1-10. Thus, these claims are rejected using the same rationale.

Claims 23 and 24:

These claims are for a document created by the method of Claims 1, 4, 5 and 10. Thus, these claims are rejected using the same rationale.

Claims 25 and 26:

These claims are for a computer network that performs the method of Claims 1, 11 and 12. Thus, these claims are rejected using the same rationale.

Claims 1-10 and 13-25 are rejected under 35 U.S.C. 102(a) as being anticipated by Aitken, Peter, Sams Teach Yourself Microsoft Word 2000, Sams Publishing (28 April 1999).

Claim 1:

Aitken discloses a method of inserting a data object into a computer-generated document (see Chapter 18 -- "Defining an AutoCorrect Entry"), comprising:

Art Unit: 2178

- converting a selected text portion of said computer-generated document containing at least one text instruction symbol into a data object (the reference discloses that the AutoCorrect feature can be used to add special symbols into a document; AutoCorrect “selects” a “text portion” of the document that contains a “text instruction symbol” in that it scans a document for a specific text pattern and, upon finding that specific text pattern, replaces it with a special symbol; the reference give an example that AutoCorrect can be used to replace “->” with an arrow symbol); and
- returning said data object for insertion in said computer-generated document (AutoCorrect “returns the data object for insertion into the document” in that, upon finding the specific text pattern, it replaces the specific text pattern with a special symbol).

Claim 2:

Aitken discloses the method of Claim 1, further comprising:

- inserting said at least one text instruction symbol in the form of text characters into the computer-generated document (the reference discloses this step in that AutoCorrect enters the specific text pattern into the document).

Claim 3:

Aitken discloses the method of Claim 2, further comprising:

Art Unit: 2178

- selecting said text portion of said computer-generated document containing said at least one text instruction symbol (the reference discloses this step in that the specific text pattern includes the “text instruction symbol”).

Claim 4:

Aitken discloses the method of Claim 1, wherein the data object comprises a mathematical formula (the reference discloses this step in that the “data object” could be “ $2 + 2 = 4$ ”).

Claim 5:

Aitken discloses the method of Claim 1, wherein the data object comprises at least one Greek character (the reference discloses this step in that the “data object” could be “ Σ ”).

Claim 6:

Aitken discloses the method of Claim 1, wherein text characters in the selected text portion, which do not form a text instruction symbol, remain unchanged during the converting operation (the reference discloses this step in that text characters “within the selected text portion” that do not form part of the text instruction symbol remain unchanged).

Claim 7:

Aitken discloses the method of Claim 1, further comprising:

- inserting the returned data object into the computer-generated document at a position of the selected text portion (the reference discloses this step in that the “data object” is entered into the document at the location of the “selected text portion”).

Claim 8:

Aitken discloses the method of Claim 7, wherein content surrounding the data object has a format, and said method further comprises formatting the returned data object using said format (the reference discloses this step in that the text “surrounding the data object” is formatted in a particular font and size and the “returned data object” will be formatted using the same font and size).

Claim 9:

Aitken discloses the method of Claim 1, further comprising:

- storing the data object with the computer-generated document (the reference discloses this step in that the “data object” is stored with the document when the document is saved).

Claim 10:

Aitken discloses the method of Claim 1, wherein the data object is reconvertible into the text portion representing the data object (the reference discloses this step in that an AutoCorrect entry can be “undone” by the edit tool).

Claims 13-22:

These claims are for computer software that performs the method of Claims 1-10. Thus, these claims are rejected using the same rationale.

Claims 23 and 24:

These claims are for a document created by the method of Claims 1, 4, 5 and 10. Thus, these claims are rejected using the same rationale.

Claim 25:

This claim is for a computer network that performs the method of Claim 1. Thus, this claim is rejected using the same rationale.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the

invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 11, 12 and 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Martel, Jr. et al., U.S. Patent No. 5,251,292.

Claim 11:

As indicated in the above discussion, Martel discloses the method of Claim 1.

Martel fails to expressly disclose that the method is downloaded. However, it was well-known by one of ordinary skill in the art at the time the invention was made to place an editing tool, like the equation editor, on a computer network server so that it can be downloaded by peripheral users of the computer network for the purpose of providing use of the tool to all peripheral users.

Accordingly, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the method of inserting a data object into a computer-generated document, disclosed in Martel, to download the method for the purpose of providing use of the tool to all peripheral users of the computer network.

Claim 12:

As indicated in the above discussion, Martel discloses the method of Claim 1.

Martel fails to expressly disclose that the method is stored on a first computer system and said computer generated document is stored on a second computer system. However, it was well-known by one of ordinary skill in the art at the time the invention was made to place an editing tool, like the equation editor, on a server of a first computer network and save the documents on a second computer network so that

users of the second computer network can remotely access the editing tool and save the documents that they create on a local computer.

Accordingly, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the method of inserting a data object into a computer-generated document, disclosed in Martel, to store the method on a first computer system and store the computer generated document on a second computer system for the purpose of allowing the users of the second computer network to remotely access the editing tool yet save the documents that they create on a local computer.

Claim 26:

This claim is for a computer network that performs the method of Claims 11 and 12. Thus, this claim is rejected using the same rationale.

Claims 11, 12 and 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Aitken, Peter, Sams Teach Yourself Microsoft Word 2000, Sams Publishing (28 April 1999).

Claim 11:

As indicated in the above discussion, Aitken discloses the method of Claim 1. Aitken fails to expressly disclose that the method is downloaded. However, it was well-known by one of ordinary skill in the art at the time the invention was made to

place an editing tool, like the AutoCorrect tool, on a computer network server so that it can be downloaded by peripheral users of the computer network for the purpose of providing use of the tool to all peripheral users.

Accordingly, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the method of inserting a data object into a computer-generated document, disclosed in Aitken, to download the method for the purpose of providing use of the tool to all peripheral users of the computer network.

Claim 12:

As indicated in the above discussion, Aitken discloses the method of Claim 1.

Aitken fails to expressly disclose that the method is stored on a first computer system and said computer generated document is stored on a second computer system. However, it was well-known by one of ordinary skill in the art at the time the invention was made to place an editing tool, like the AutoCorrect tool, on a server of a first computer network and save the documents on a second computer network so that users of the second computer network can remotely access the editing tool and save the documents that they create on a local computer.

Accordingly, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the method of inserting a data object into a computer-generated document, disclosed in Aitken, to store the method on a first computer system and store the computer generated document on a second computer system for the purpose of allowing the users of the second computer network to

Art Unit: 2178

remotely access the editing tool yet save the documents that they create on a local computer.

Claim 26:

This claim is for a computer network that performs the method of Claims 11 and 12. Thus, this claim is rejected using the same rationale.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure: Jenks, U.S. Patent No. 6,610,106; and Satoh, U.S. Patent No. 5,680,638.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Doug Hutton whose telephone number is (703) 305-1701. The examiner can normally be reached on Monday-Friday from 8:00 AM to 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Heather Herndon, can be reached at (703) 308-5186. The fax phone number for the organization where this application or proceeding is assigned is (703) 746-7239.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-3900.

Application/Control Number: 09/728,793
Art Unit: 2178

Page 19

WDH
April 13, 2004


HEATHER HERNDON
SUPERVISORY PATENT EXAMINER
TECH CENTER 2100